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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/710,306	11/09/2000	Kazue Sako	14051	5037
23389	7590	10/18/2005	EXAMINER	
SCULLY SCOTT MURPHY & PRESSER, PC 400 GARDEN CITY PLAZA SUITE 300 GARDEN CITY, NY 11530			ABDI, KAMBIZ	
			ART UNIT	PAPER NUMBER
			3621	

DATE MAILED: 10/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/710,306	SAKO, KAZUE
	Examiner	Art Unit
	Kambiz Abdi	3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 25 July 2005.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 2-7,9-14 and 16-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 2-7,9-14 and 16-22 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____. | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____. |

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DETAILED ACTION

1. The prior office actions are incorporated herein by reference. In particular, the observations with respect to claim language, and response to previously presented arguments.

- Claims 1, 8, and 15 are canceled.
- Claims 2, 9, and 16 are amended.
- Claims 2-7, 9-14, and 16-22 are pending.

2. Claims 2, 9 and 16 were rejected under 35 U.S.C. § 112, second paragraph the rejections are withdrawn based on the amendments made by the applicant.

Response to Arguments

3. Applicant's arguments filed 25 July 2005 have been fully considered but they are not persuasive for the following reasons:

4. Based on the office actions mailed on 28 October 2004 and 21 March 2005 and the arguments that were presented to the applicant as in regards to the clarity of the prior art in the claimed invention examiner would like to elaborate further;

5. The examiner believes that the argument that the applicant has put forward on regards to claims 2, 9, and 16 are not persuasive to over come the prior art of record. Applicant has miss characterized the examiner's characterization of the Lee et al. reference as well as the Pierce '384 and '139. Lee et al. reference teaches the limitations of the claims as they have been presented in their current forms in the claims. What examiner has pointed to is that Lee et al. along with Pierce '348 teach all the steps of the claims as they are presented in their current form, what the combination does not teach is that there is a communication with a data center to accomplish a verification of the stamp verses the claims stating that there is no such communication for the verification of stamp with a data center or a third party. However, Pierce '139 clearly teaches the specific limitation that there is no need of communication with a data center for the verifying means to verify the stamp (See Pierce '139, column 2, lines 6-14 and column 3, lines 44-58). Pierce '139 clearly states that the problem to be solved by the invention is removal of such

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communication. As it has been understood by the examiner the interpretation of the applicant of the Pierce '139 is not proper, as Pierce '139 is clearly disclosing the fact that there is no need to communicate with a data center or a third party to verify the stamp, it states that such verification is accomplished just by checking the digital signature based on the cryptographic hash generated at the receiving apparatus (here the postal refund authority) and matching the generated hash with the has that was included with the stamp (See Pierce '139 column 2, line 53-column 3, line 9).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 2-7, 9-14, 16-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 6,285,990 to David K. Lee et al. in view of U.S. Patent 6,058,384 to Perry A. Pierce et al. and U.S. Patent 6,427,139 to Perry A. Pierce.

8. As per claims 2, 9, and 16, Lee discloses an electronic revenue stamp issuing apparatus, method, and storage device, comprising:

- request means for making a request for issuance of an electronic revenue stamp for a user-determined amount, said user-determined amount being a value or cost of the electronic revenue stamp, said request being made by a receiver (See Lee column 7, lines 35-64);
- debit means for tracking remaining value of a prepaid amount, said prepaid amount being reduced, each time an electronic revenue stamp is issued, by said value or cost of said electronic revenue stamp (See Lee column 7, line 65-column 8, line 19);

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- a judging means for judging whether the amount of said electronic revenue stamp to be issued is equal to or less than said prepaid amount (See Lee figures 2, 3, 5A-C and 7 and associated text, see column 4, lines 51-68, column 5, line 1-63);
- an issuing means for issuing said electronic revenue stamp as data on a document (See Lee figures 2, 3, 5A-C and 7 and associated text, see column 4, lines 51-68, column 5, line 1-63), said issuer means giving a serial number with said data to said electronic revenue stamp, said data containing a digital signature of said electronic revenue stamp issuing apparatus on a message, said message including the document which said electronic revenue stamp is attached to, the amount of said electronic revenue stamp (See Lee figures 2, 3, 5A-C and 7 and associated text, see column 4, lines 51-68, column 5, line 1-63), and an identifier of a receiver of said electronic revenue stamp, if said amount of said revenue stamp is judged to be equal to or less than said prepaid amount by said judging means (See Lee figures 2, 3, 5A-C and 7 and associated text, see column 4, lines 51-68, column 5, line 1-63);
- a balance amount reducing means for reducing of said debit means by said value or cost of said electronic revenue stamp if said electronic revenue stamp is issued (See Lee figures 2, 3, 5A-C and 7 and associated text, see column 4, lines 51-68, column 5, line 1-63, column 6, lines 1-68, and column 7, lines 1-25);

What is not clear and explicit in Lee is the usage of the signature for further security and additional information transfer within the indicia. Lee clearly discloses the use of digital token as means of secure transaction within the metering system and record keeping for further tracking of indicia issuing and book keeping.

However, Pierce (384) clearly teaches the steps of using specifically a digital signature in order for further securing issuance and refunding of revenue stamps (See Pierce (384) figure 2 and associated text, column 1, lines 19-64, column 2, lines 1-58, column 4, lines 1-64).

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Therefore, it would have been obvious to one having ordinary skill in the art at the time the current invention was made to combine the Lee and Pierce teachings for creating revenue stamps and a more efficient, less processing time, and better security control of refunding unused revenue stamps.

Additionally, what Lee and Pierce '384 are not clear and explicit on is the following limitations is the specific use of signature as the verifying means as well as the absence of the communication to a data center for such verification. However, Pierce '384 clearly teaches,

- a verifying means that is part of the stamp issuing apparatus, for receiving a digital certificate for making an electronic revenue stamp invalid, said digital certificate containing a digital signature of said receiver, and verifying whether said distal certificate is valid or not by using an identifier of said receiver; (See Pierce (384) abstract, figures 1and 2 along with the associated text, column 1, lines 19-64, column 2, lines 1-58, column 4, lines 1-64, column 5, lines 10-68 and column 6, lines 1-53 and Pierce (139) figure 3 and column 2, lines 53-65 and column 3, lines 10-15);
- an amount increasing means for increasing said prepaid amount by an amount equal to the value or cost of said invalidated electronic revenue stamp (See Pierce (384) abstract, figures 1and 2 along with the associated text, column 1, lines 19-64, column 2, lines 1-58, column 4, lines 1-64, column 5, lines 10-68 and column 6, lines 1-53); and
- an invalid electronic revenue stamp recording means for recording receipt of said distal certificate (See Pierce (384) abstract, figures 1and 2 along with the associated text, column 1, lines 19-64, column 2, lines 1-58, column 4, lines 1-64, column 5, lines 10-68 and column 6, lines 1-53).

What is not clear and explicit in Lee and Pierce (384) is the absence of the communication between the first entity (issuer of the refund stamp) and the receiving entity (here the postal refund authority) in the verification step of above claimed invention. However, Pierce (139) clearly teaches and discloses a system and method to make a verification of the digital certificate and the

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signature without communication with a data center (See Pierce '139, column 2, lines 53- column3, lines 15 and lines 44-58, column 5, lines 37-52).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the current invention was made to combine the Lee and the two Pierce systems for creating revenue stamps generators that are more efficient, less processing time consuming, less need for communication lines and better security control of refunding unused revenue stamps or making payments for other services.

9. As per claims 3, 10, and 17, Lee and Pierce teach all the limitations of claims 1, 8, and 15 further;

What Lee is not clear and explicit on is the following limitations. However, Pierce clearly teaches,

- said issuing means issues an issue number of said electronic revenue stamp issuing apparatus to said electronic revenue stamp, and
- said message include said issue number (See Pierce abstract, figures 1and 2 along with the associated text, column 1, lines 19-64, column 2, lines 1-58, column 4, lines 1-64, column 5, lines 10-68 and column 6, lines 1-53).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the current invention was made to combine the Lee and Pierce systems for creating revenue stamps and a more efficient, less processing time consuming, and better security control of refunding unused revenue stamps.

10. As per claims 4, 11, and 18, Lee and Pierce teach all the limitations of claims 2, 9, and 15 further;

What Lee is not clear and explicit on is the following limitations. However, Pierce clearly teaches,

- said verifying means verifies whether said digital certificate making electronic revenue stamp invalid is valid or not, by using said identifier of said receiver and an issue number of said electronic revenue stamp issuing apparatus (See Pierce abstract, figures 1and 2 along

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with the associated text, column 1, lines 19-64, column 2, lines 1-58, column 4, lines 1-64, column 5, lines 10-68 and column 6, lines 1-53).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the current invention was made to combine the Lee and Pierce systems for creating revenue stamps and a more efficient, less processing time consuming, and better security control of refunding unused revenue stamps.

11. As per claims 5, 12, and 19, Lee and Pierce teach all the limitations of claim 2, further;

What Lee is not clear and explicit on is the following limitations. However, Pierce clearly teaches,

- invalid electronic revenue stamp data for storing data of electronic revenue stamps made to be invalid (See Pierce abstract, figures 1and 2 along with the associated text, column 1, lines 19-64, column 2, lines 1-58, column 4, lines 1-64, column 5, lines 10-68 and column 6, lines 1-53).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the current invention was made to combine the Lee and Pierce systems for creating revenue stamps and a more efficient, less processing time consuming, and better security control of refunding unused revenue stamps.

12. As per claims 6, 13, and 20, Lee and Pierce teach all the limitations of claims 1, 8, and 14 further;

What Lee is not clear and explicit on is the following limitations. However, Pierce clearly teaches,

- an issued electronic revenue stamp recording means which records issued electronic revenue stamps (See Pierce abstract, figures 1and 2 along with the associated text, column 1, lines 19-64, column 2, lines 1-58, column 4, lines 1-64, column 5, lines 10-68 and column 6, lines 1-53); and

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- storing means for issued electronic revenue stamp data and invalid electronic revenue stamp data (See Pierce abstract, figures 1and 2 along with the associated text, column 1, lines 19-64, column 2, lines 1-58, column 4, lines 1-64, column 5, lines 10-68 and column 6, lines 1-53).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the current invention was made to combine the Lee and Pierce systems for creating revenue stamps and a more efficient, less processing time consuming, and better security control of refunding unused revenue stamps.

13. As per claims 7, 14, and 21 Lee and Pierce teach all the limitations of claims 2, 9, and 15 further; What Lee is not clear and explicit on is the following limitations. However, Pierce clearly teaches,

- said verifying means verifies that said digital certificate making electronic revenue stamp invalid is issued for an electronic revenue stamp issued by said electronic revenue stamp issuing apparatus and also issued by a receiver who is a valid receiver of said electronic revenue stamp, and also verifies that said digital certificate making electronic revenue stamp invalid was not used before (See Pierce abstract, figures 1and 2 along with the associated text, column 1, lines 19-64, column 2, lines 1-58, column 4, lines 1-64, column 5, lines 10-68 and column 6, lines 1-53).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the current invention was made to combine the Lee and Pierce systems for creating revenue stamps and a more efficient, less processing time consuming, and better security control of refunding unused revenue stamps.

14. As per claim 22, Lee and Pierce clearly teach all the limitations of claim 15, further; Lee discloses,

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- said program storage device storing said control program of said electronic revenue stamp issuing method is an IC card (See Lee figures 1, 2, 3 and 7 and associated text, abstract, and column 5, line 20-68, column 6, lines 1-68 and column 7, lines 1-64).
15. Examiner has pointed out particular references contained in the prior arts of record in the body of this action for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the response, to consider fully the entire references as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior arts or disclosed by the examiner.

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Conclusion

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
 - International Application Publication No. WO 97/40472 to Gary Gardner, Secure Postage Payment system and Method.
17. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
18. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.
19. Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the examiner should be directed to **Kambiz Abdi** whose telephone number is **(571) 272-6702**. The Examiner can normally be reached on Monday-Friday, 9:30am-5:00pm. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, **James Trammell** can be reached at **(571) 272-6712**.
20. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see
<http://portal.uspto.gov/external/portal/pair>.

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Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any response to this action should be mailed to:

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(571) 273-8300 [Official communications; including After Final communications labeled "Box AF"]

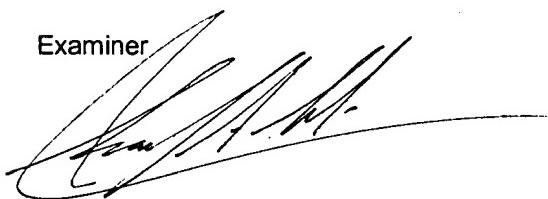
(571) 273-6702 [Informal/Draft communications, labeled "PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to the Examiner in the

Knox Building, 50 Dulany St. Alexandria, VA.

Kambiz Abdi

Examiner



October 13, 2005